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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,775	01/07/2005	Joseph Leibenguth	09669/044001	2427
22511 7590 06/25/2007 OSHA LIANG L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010			EXAMINER KIM, AHSNIK	
			ART UNIT 2876	PAPER NUMBER
			MAIL DATE 06/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/520,775

Applicant(s)

LEIBENGUTH ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/7/05 (initial filing of application).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/6/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The first sentence under SUMMARY OF THE INVENTION needs to be clarified. It states, "It is an object of the invention to allow a reduction of the cost." It is unclear in what area "reduction of the cost" is achieved. Perhaps, it can be replaced with "it is an object of the invention to allow a reduction of the cost in manufacturing data carriers" or similar sentence.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, and 5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Lind et al. (US 2006/0187805, hereinafter "Lind").

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Re claims 1 and 9, Lind discloses a system comprising a first data carrier 301 and a second data carrier 601, the first data carrier 301 being detachably attached to the second data carrier (see abstract, paragraphs 0008 and 0010). The second data carrier is read by the reading unit (paragraph 0054 0064); and although not explicitly stated, it is the Examiner's position that
5 SIM card – the first data carrier - is accessed with the reader reading from and/or writing the information to the SIM card.

Re claim 2, the assembly is made of polymer material including polycarbonate (see paragraph 0003); and the SIM plug is made of a plastic or polymer material.

Re claim 5, the first carrier is a GMS plug (paragraph 0038) and the second data carrier is
10 an optical card (0008). Also see figures 7a-9.

Re claim 6, as shown in figure 9, the detachable module can be attached to the optical carrier by way of a bridge 301 (see figure 9 and paragraph 0076). The bridge can certainly be considered a clipping element. SIM card can be attached to the optical carrier.

Re claim 7, relying on figure 6, the detachable module are attached on the grooves 301 of
15 the optical medium. Although not explicitly stated, the detachable module has to pressed/pushed down on the groove.

Re claim 8, the groove 301 is also a breaking line between which goes through the edges of the detachable module (see figure 7a).

Re claim 9, Lind also discloses a method for production of an optical disc with a
20 detachable module (see abstract).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the
10 claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
15 and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lind et al. (US 2006/0187805) in view of Ladyansky (US 6,758,404, hereinafter "Ladyyansky").

The teachings of Lind have been discussed above.

Lind fails to specifically teach or fairly suggest that the detachable module is made of
20 acrylonitrile butadiene styrene (ABS) or polyvinylchloride (PVC).

Ladyansky teaches a chip card which is a GSM card made of acrylonitrile butadiene styrene (ABS) or polyvinylchloride (PVC) (col. 9, lines 34+; col. 10, lines 25+).

In view of Ladansky's teaching, acrylonitrile butadiene styrene (ABS) or polyvinylchloride (PVC) are well known material in manufacturing various cards including SIM,
25 GSM and other cards. Accordingly, it would have been obvious to an ordinary skill in the art at

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the time the invention was made to well-known ABS or PVC which may be readily available, therefore reducing the manufacturing cost.

Conclusion

5 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Vogt et al. (US 2003/0173409); Fidalgo et al. (US 6,448,638); Dilday et al. (US 7,080,783); Conner et al. (US 6,832,730); Schoppe (US 6,760,280) disclose various embodiments of data carriers. Applicant is respectfully suggested to carefully review these references.

10 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 8:00 AM to 5:00 PM Monday thru Friday.

15 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax phone number for this Group is (571)273-8300.

20 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

25 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

30 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available for Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions or access to the Private PAIR
35 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ahshik Kim

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Primary Examiner
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June 12, 2007